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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/053,797

01/18/2002

Mark C. Myrhum

11739

4271

23562

7590

06/22/2006

BAKER & MCKENZIE LLP
PATENT DEPARTMENT
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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,797

Applicant(s)

MYRHUM ET AL.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-93 is/are pending in the application.
- 4a) Of the above claim(s) 21-73 and 85-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 74-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/18/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request of Continued Examination (RCE)

1. The request filed on 14 June 2005 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/053,797 is acceptable and a RCE has been established. An action on the RCE follows.

Election/Restrictions

2. Newly submitted claims 85-93 directed to an invention that is independent or distinct from the invention originally elected invention of the golf club for the following reasons: There are other heads which the method can be used with as heads which receive inserts at different locations than the crown and sole to alter the center of gravity (i.e. sole only, crown only, back only, etc...).

Since applicant has received an action on the merits for the originally presented and elected invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 85-93 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 74-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Ryan, and McCabe.

Vincent discloses a head having a crown (Fig. 11) fitting configured to receive an insert (Fig. 25) and a sole plate (Fig. 12) fitting configured to receive an insert (Fig. 25) producing a desired center of gravity.

Vincent lacks a club having a plurality of possible centers of gravity, crown and sole weight inserts with each insert comprising a weight configured to achieve a desired one of the possible centers of gravity without effecting the overall weight of a head, and to have crown or sole weights being lighter, heavier, or medium.

Ryan discloses a club having a plurality of possible centers of gravity (Figs. 10-11), heel and toe weight inserts with each insert comprising a weight configured to achieve a desired one of the possible centers of gravity without effecting the overall weight of a head in the form of placing either the heavy weights on one side of the head and light weights on the other side of the head (Figs. 10-11), and heel or toe weights being lighter, heavier, or medium (Figs. 10, 11 and 13) in order to be able to move the center of gravity (Abstract). McCabe discloses first setting the overall weight of a head

Art Unit: 3711

and than adjust the vertical weight of a head in order to set the desired center of gravity location (Col. 5, Lns. 20-32). In view of the patents of Ryan and McCabe it would have been obvious to modify the club of Vincent to have a club having a plurality of possible centers of gravity and crown and sole weight inserts with each insert comprising a weight configured to achieve a desired one of the possible centers of gravity without effecting the overall weight of a head and crown or sole weights being lighter, heavier, or medium in order to have a club which a player is able to select the desired center of gravity location in the vertical direction but still maintain an overall weight of a head.

5. Claims 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Ryan, and McCabe as applied to claims 74-80 above, and further in view of Wood.

Vincent lacks a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate.

Wood discloses a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole being recessed around an aperture so a fastener does not extend beyond the sole (Fig. 2) in order to have an adjustable lie (Col. 2, Lns. 13-25). In view of the patent of Wood it would have been obvious to modify the head of Vincent to have a bore sized to receive a hosel fitting affixed to an end of a

Art Unit: 3711

shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate in order to have adjustable lie woods.

6. Claims 74-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Sahm, and McCabe.

Vincent discloses a head having a crown (Fig. 11) fitting configured to receive an insert (Fig. 25) and a sole plate (Fig. 12) fitting configured to receive an insert (Fig. 25) producing a desired center of gravity.

Vincent lacks a club having a plurality of possible centers of gravity, crown and sole weight inserts with each insert comprising a weight configured to achieve a desired one of the possible centers of gravity without effecting the overall weight of a head, and to have crown or sole weights being lighter, heavier, or medium.

Sahm discloses a club having a plurality of possible centers of gravity, heel and toe weight inserts with each insert comprising a weight configured to achieve a desired one of the possible centers of gravity without effecting the overall weight of a head (Col. 5, Lns. 5-10, B,A,A and A,A,B configurations, Col. 7, Lns. 1-20) and weights being lighter, heavier, or medium (Col. 4, Lns. 34-36, 51-52) in order to change the mass distribution of a head (Col. 5, Lns. 1-4). McCabe discloses first setting the overall weight of a head and than adjust the vertical weight of a head in order to set the desired center of gravity location (Col. 5, Lns. 20-32). In view of the patents of Sahm and

McCabe it would have been obvious to modify the club of Vincent to have a club having a plurality of possible centers of gravity and crown and sole weight inserts with each insert comprising a weight configured to achieve a desired one of the possible centers of gravity without effecting the overall weight of a head and crown or sole weights being lighter, heavier, or medium in order to have a club which a player is able to select the desired center of gravity location in the vertical direction but still maintain an overall weight of a head.

7. Claims 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent in view of Sahm, and McCabe as applied to claims 74-80 above, and further in view of Wood.

Vincent lacks a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate.

Wood discloses a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in an aperture fastening a shaft to a head, and a sole being recessed around an aperture so a fastener does not extend beyond the sole (Fig. 2) in order to have an adjustable lie (Col. 2, Lns. 13-25). In view of the patent of Wood it would have been obvious to modify the head of Vincent to have a bore sized to receive a hosel fitting affixed to an end of a shaft, a bore oriented so a shaft will have a proper orientation to a head, a fastener in

an aperture fastening a shaft to a head, and a sole plate being recessed around an aperture so a fastener does not extend beyond the sole plate in order to have adjustable lie woods.

Response to Arguments

8. Applicant's arguments with respect to claims 74-84 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Slb/ 19 June 2006


STEPHEN BLAU
PRIMARY EXAMINER